

08/14/2003 TTAB

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Attorney

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,176,916
Registration Date: July 28, 1998

CENTRAL PRODUCTS COMPANY and
INTERTAPE POLYMER CORPORATION

Petitioners,

v.

3M COMPANY,

Registrant.



07-28-2003

U.S. Patent & TMO/TM Mail Rpt'Dt: #22

Cancellation No. 41,254

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AMENDED PETITION FOR CANCELLATION

Central Products Company (“Central Products”) and Intertape Polymer Corporation (“Intertape Polymer”), Delaware corporations with their principal places of business at 3647 West Cortez Road, Bradenton, Florida 34210, believe that they are being damaged by Registration No. 2,176,916, owned by 3M Company (“Registrant”), a Delaware corporation having its principal place of business at 2501 Hudson Road, St. Paul, Minnesota 55144, and hereby petition to cancel such registration.

As grounds for cancellation, it is alleged as follows:

1. Central Products, Intertape Polymer, and their respective predecessors-in-interest (collectively "Petitioners") have adopted and used various shades of blue in connection with premium-quality masking tape, including painter's tape, since at least as early as 1990.

2. Registration No. 2,176,916 was issued by the U.S. Patent and Trademark Office ("Office") to Registrant's predecessor-in-interest on July 28, 1998 under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), on the basis of acquired distinctiveness. Registrant is the owner of this registration as shown by the Assignment Records of the Office at Trademark Reel 2502, Frame 0547.

3. Registration No. 2,176,916, now sought to be cancelled, is for the trademark MISCELLANEOUS DESIGN, registered for use on premium-quality masking tape in Class 17. The description of the mark as originally registered read, in part: "The mark consists of the single color blue as applied to the entirety of the goods." The lining statement for the mark as originally registered read: "The drawing is lined for blue and color is claimed as a feature of the mark." On January 16, 2003, Registrant filed a post-registration request to narrow the description of the mark to read, in part: "The mark consists of a particular shade of the color blue, sometimes referred to as medium blue, applied to the entire surface of the goods."

4. Registration No. 2,176,916 is not "incontestable" under Section 15 of the Lanham Act, 15 U.S.C. § 1065.

5. Upon information and belief, Registrant's Section 2(f) claim of acquired distinctiveness was improperly accepted because the Office based its finding of acquired distinctiveness upon false and misleading information provided by Registrant. At the time Registrant filed the application which issued as Registration No. 2,176,916, Petitioners and a number of other members of the tape industry were selling commercially significant amounts of blue premium-quality masking tape, including painter's tape, and Registrant was clearly aware

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this. Nevertheless, Registrant made several false and misleading statements regarding the substantial exclusivity of its use of blue premium-quality masking tape in support of its claim of acquired distinctiveness. Specifically, Registrant misled the Office by making statements that it had “substantially exclusive and continuous use of the mark on the goods in interstate commerce for at least nine years before the date on which the claim of distinctiveness is made” and that it “continues to produce nearly all of the goods in the market which use any form of blue on the goods themselves.” Had the Office known the true facts – that blue had been used by a number of members of the tape industry for commercially significant amounts of premium-quality masking tape for several years prior to Registrant’s misleading claim of acquired distinctiveness – the Office would not have issued Registrant a registration for “the single color blue.” Thus, Registrant did not meet the standards for acquired distinctiveness under Section 2(f). Accordingly, Registration No. 2,176,916 is invalid and should be cancelled.

6. Upon information and belief, Registration No. 2,176,916 was fraudulently obtained because Registrant, in its application to register “the single color blue” for premium-quality masking tape, intentionally made misrepresentations to the Office concerning material facts. Contrary to Registrant’s allegations and claims set forth in its application, Registrant’s use of the color blue for premium-quality masking tape was *not* substantially exclusive at the time of filing of the application and, indeed, is still not substantially exclusive. Registrant was aware that a number of tape industry members, including Petitioners, were using blue for commercially significant amounts of premium-quality masking tape prior to and at the time Registrant filed its application for its blue premium-quality masking tape. Nevertheless, Registrant intentionally and falsely stated in its application that it “continues to produce nearly all of the goods in the market which use any form of blue on the goods themselves” and intentionally misled the Office by stating that “[c]ompetitors offer the goods in colors other than blue.” Had Registrant not intentionally provided the Office with false and misleading information regarding the acquired distinctiveness of blue on premium-quality masking tape and its substantially exclusive use of “the single color blue,” Registration No. 2,176,916 would not have been granted. Thus, Registrant obtained its registration by fraud. Accordingly, Registration No. 2,176,916 is invalid and should be cancelled.

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7. Registration No. 2,176,916 should be cancelled on the basis that the mark had not acquired secondary meaning during prosecution of the application and, indeed, still has not acquired distinctiveness. Upon information and belief, a number of members of the tape industry, including Petitioners, were selling commercially significant amounts of blue premium-quality masking tape, both prior to the time Registrant filed its application for its blue premium-quality masking tape and during the time relied upon by Registrant to support its Section 2(f) claim of acquired distinctiveness. Blue colored masking tape is viewed by consumers as designating a *type* of masking tape (premium-quality or painter's), rather than the *source* (in the trademark sense) of a particular masking tape. In light of numerous companies' uses of commercially significant amounts of blue masking tape, Registrant did not and cannot prove its substantially exclusive use of blue in connection with premium-quality masking tape.

8. Registrant's mark is a generic and/or functional "grade designation" when used in connection with Registrant's premium-quality masking tape. Registrant, as well as other members of the tape industry, sell premium-quality masking tapes in several colors including blue, white, green and beige. Registrant's product brochures advertise this variety of colors. Upon information and belief, Registrant's blue masking tapes are intended to be used for painted surfaces and glass, and for faux and decorative painting; its white masking tape is intended to be used for delicate surfaces; its green masking tape is intended to be used for hard-to-stick surfaces; and, of its two beige masking tapes, one is intended to be used for trim and woodwork and the other for general purposes. Inasmuch as Registrant's blue color functions merely as part of a color-coding system to identify its various *types* of masking tapes and not to identify and distinguish the *source* of Registrant's masking tape, Registrant's blue color is generic and/or functional. Thus, Registration No. 2,176,916 should be cancelled.

9. The use of blue on masking tape, including painter's tape, is functional in that the color blue is amenable to absorbing ultraviolet radiation and is an aesthetically-pleasing color that provides a contrast with other colors typically used in painting applications.

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10. If Registrant is permitted to maintain Registration No. 2,176,916, such registration would continue to be a source of damage and injury to Petitioners and others in the tape industry who use blue to indicate a *type* of masking tape, requiring Petitioners and others to abandon their use and change their promotional and advertising tactics, all to the great expense and detriment of Petitioners and others in the trade.

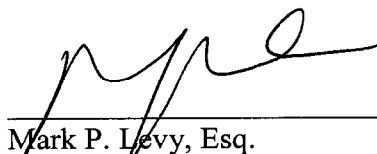
11. Furthermore, if Registrant is permitted to maintain Registration No. 2,176,916, such registration may be deemed "incontestable" after five years from its date of registration and Petitioners and others in the trade would be additionally damaged.

WHEREFORE, Petitioners deem that they are being damaged by the continued existence of Registration No. 2,176,916, and thus petition for cancellation thereof.

A duplicate copy of this Petition for Cancellation is submitted herewith. The fee required in § 2.6(a)(16) previously has been submitted.

Respectfully submitted,

Date: 7-24-03



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